

Remarks

The Office Action of August 24, 2007 and cited prior art references were reviewed with care in the preparation of this amendment and response.

After the above amendment, claims 77-84, 86 are pending in the application. Allowance of all claims, as amended, is respectfully requested.

Interview Summary

The undersigned thanks Examiner Parsley for the interview of November 26, 2007, at which the above amendment was discussed. Participating in the interview were the undersigned attorney and paralegal Tatstsana Fenster.

More specifically, the above amendment, amends independent claims 77 and 86 to require that the switch have an LED-light passage portion therethrough. This amendment should not prompt any new search because no new element has been raised, rather, the previously examined and searched limitation of dependent claim 78 has been added to independent claims 77 and 86. In addition, to simplify prosecution, applicants proposed cancelling independent claim 91 and have now done so.

At the interview, the undersigned attorney pointed out that, according to MPEP 2143.01, paragraphs I, IV and V, the Cooper et al. and Blaschke references may not be combined because such combination would render each reference unsatisfactory for its intended purpose.

During the interview, the Examiner said that the undersigned attorney brought up valid points and good arguments regarding the references. In particular, he stated that the invention as claimed is distinguishable over the Shiao reference. The undersigned appreciates the Examiner's specific indication that he will consider the amendment and arguments now being filed on this matter, and that if he makes another rejection it will not be made final. In the section below where the outstanding rejections of claims are discussed, substantial arguments, based on Rules and case law, are made to show that the cited references do *not* render obvious applicants' invention as now claimed.

Points in the Office Action

Claims 77, 80-82, 84, 86 and 91 were rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke. Claim 91 has been cancelled without prejudice. Claims 77, 80-82, 84 and 86 are in condition for allowance, as set forth below.

The Cooper et al. patent discloses a Pen Size LED Inspection Lamp for Detecting Fluorescent Material. The inspection lamp has a narrow shape adapted for insertion into narrow areas close to a suspected leak site such as lines and connectors in the circuit of an automobile air conditioner. The Cooper et al. patent further teaches a mirror attached to the inspection lamp to increase ability to detect leaks in hard-to-see areas such as around corners or underside surfaces. Therefore, it is essential that the Cooper et al. inspection lamp be configured for access to small narrow spaces and to provide additional visibility under or around an obstruction. (col. 3, lines 7-8 and 16-18)

As the Examiner correctly noted, the Cooper et al. patent does not disclose that “the working tool is a net.” Applicants, however, respectfully disagree with the Examiner’s assertion of obviousness based on the contention that it would be obvious “to one of ordinary skill in the art to take the device of Cooper et al. and add the foldable frame and net of Blaschke”

Such modification would interfere with the Copper et al. lamp ability to be inserted into small spaces for needed inspection of suspected leaks; and the net would greatly interfere with the visibility of the inspected areas. Moreover, addition of the net would require removal of the mirror which would make the lamp completely unsuitable for inspection under and around an obstruction.

Therefore, the Cooper at al. may not be modified to include the Blaschke net because such modification would make the Cooper et al. lamp unsatisfactory for its intended purpose. MPEP 2143.01, paragraph V, titled “The Proposed Modification Cannot Render the Prior Art Unsatisfactory for its Intended Purpose,” provides that “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification” (*In re Gordon*, 733 F.2d 900,

221 USPQ 1125 (Fed. Cir. 1984)).¹ MPEP 2143.01, paragraph I, provides that, “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006).”

In addition, as previously discussed in applicants’ August 24, 2006 response, the Blaschke net collapsibility-into-the-handle feature would plainly be thought to rule out useful placement of lighting apparatus at the distal end of the handle. The reference teaches as well against a telescoping handle given that, by its very nature, the Blaschke device involves using the handle space for purposes relating to compact storage, which is incompatible with the idea of reasonable placement of lighting apparatus at that location. In Blaschke, placing a light in the distal end of the handle would not be possible because the net is retracted into the handle; a light at that location would destroy the central purpose of Blaschke and the same thinking would apply to telescoping handles. Therefore, the Blaschke device would be rendered inoperable by the Examiner's proposed modification.

With all this in mind, it can be seen that the rejection does not establish a *prima facie* obviousness and should be withdrawn. Independent claims 77 with all its dependent claims, including claims 80-82 and 84, and independent claim 86 are patentably distinct over the Cooper et al. and Blaschke, alone or in combination.

Further, independent claims 77 and 86 have been amended to include a limitation of claim 78 requiring that the switch have an LED-light passage portion therethrough.

The Examiner is correct in noting that neither Copper et al. nor Blaschke discloses a switch such as is required by the applicants’ amended claims 77 and 86. Applicants, however, respectfully disagree with the Examiner’s assertion that Shiao does disclose a switch having a light passage portion therethrough. In the Shiao magnetic retriever the tubular sleeve 22 is

¹MPEP 2143.01, paragraph IV, provides that, “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 US at ___, 82 USPQ2d at 1396, quoting *In re Kahn*, 441 F.3d 977, 088, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).”

positioned behind the lamp 50 and in the opposite direction of the emitted light. In addition, both ends of the sleeve 22 are closed with non-transparent structures such as batteries 30 at one end and the lamp base at the other end, prohibiting light from passing through the sleeve. Therefore, Shiao does not disclose a switch having an LED-light passage portion therethrough, as required by currently amended claims 77 and 86.

In summary, Cooper et al., Blaschke and Shiao, either alone or in combination, fail to disclose or render obvious applicants' invention as set forth in amended independent claims 77 and 86.

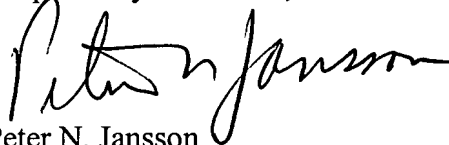
Claims 78 and 79 were rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke and further in view of Schiao. This rejection is respectfully traversed in view of the of the above comments and arguments with respect to claim 77 upon which these claims depend. Claims 78 and 79 are in condition for allowance.

Claim 83 was rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke and further in view of Brundage et al. This rejection is respectfully traversed in view of the amendment of independent claim 77, upon which this claim depends, and in view of the above comments. Brundage et al. does not disclose the switch having an LED-light passage portion therethrough, as required by amended claim 77. Therefore, claim 83 is in condition for allowance.

In view of the above, allowance of this application is hereby requested. The Examiner is invited to call the undersigned attorney to resolve any issues that might remain.

Date: November 26, 2007

Respectfully submitted,



Peter N. Jansson
Registration No. 26,185

Jansson Shupe & Munger Ltd.
245 Main Street
Racine, WI 53403
Telephone: (262) 632-6900
Facsimile: (262) 632-2257